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Cont.

40. (Amended) The blind of Claim 38, wherein the means for applying the varying amount of weight to the bottom rail include an end plug configured to be inserted in an end of the bottom rail.

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49. (Amended) A cordless blind comprising:

a headrail;

a bottom rail suspended from the headrail;

a window covering disposed between the headrail and the bottom rail;

a spring motor disposed within one of the headrail and the bottom rail configured to move the bottom rail relative to the top rail;

a balancing adjustment device configured to allow the consumer to adjust the operation of the spring motor, the balancing adjustment device being adapted to be actuated by the consumer from an area external to the one of the headrail and the bottom rail.

Please cancel claims 52 and 53 without prejudice.

REMARKS

Applicants respectfully request reconsideration of this application in view of the present amendments and the following remarks. It is believed that no additional fees are due for the consideration of this paper. However, if additional fees are due, the Commissioner is authorized to charge such fees to deposit account number 13-2855. A copy of this paper is enclosed.

Claims 12-18 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. It is respectfully submitted that claim 12 as amended herein recites proper antecedent basis for "the bias adjustment mechanism." Therefore, withdrawal of the rejection of claims 12-18 under 35 U.S.C. § 112, second paragraph is respectfully requested.

Claims 1-4 and 49 were rejected under 35 U.S.C. §102(b) as being anticipated by Kuhar (U.S. Patent No. 5,482,100), claims 5, 12, 13, 15, 17, 18 and 50-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhar in view of Griswold (U.S. Patent No. 350,429), claims 6, 7 and 9-11 were rejected under §103(a) as being unpatentable over Kuhar in view of Carouso (U.S. Patent No. 1,863,620), claim 8 was rejected under §103(a) as being unpatentable over Kuhar in view of Carouso and further in view of Conklin, Jr. (U.S. Patent No. 4,055,038), and claims 38-41 and 53 were rejected under §103(a) as being unpatentable in view of Kuhar in view of Judkins et al. (U.S. Patent No. 5,176,192). Applicants respectfully traverse the rejection of claim 12 and claims 13-18 depending therefrom, and respectfully submit that claims 1, 38 and 49 as amended herein, and claims 2-11, 39-45 and 50-52 depending therefrom, would not be properly rejectable over the applied references for the following reasons.

Claim 1 is amended to more clearly recite that the spool, and the first and second tensioning mechanisms have parallel axes. Conversely, the Kuhar reference does not appear to disclose or suggest tensioning mechanisms having any axes whatsoever, let alone axes that are parallel to the axis of the spool. Kuhar discloses a hole 49 and slots 56 through which the cords pass, but does not discuss or define axes of the hole 49 and slots 56. It follows, therefore, that the Kuhar patent neither anticipate currently pending claims 27-30 and 32-42, nor render the claims obvious. *See In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985) (the prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness). Because the Kuhar patent does not appear to teach or suggest a spool and first and second tensioning mechanisms have parallel axes, the Applicants respectfully request allowance of Claim 1 and Claims 2-11 depending therefrom at the Examiner's earliest convenience.

Regarding claim 12, Applicants respectfully submit that the combination of the Kuhar and Griswold patents proposed by the Examiner does not appear to be motivated or suggested by the references themselves or any other evidence cited by the Examiner. For rejections of

claims based on obviousness under 35 U.S.C. § 103(a), the Federal Circuit has explained the requirements under the Administrative Procedure Act¹ as follows:

When patentability turns on a question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

* * * *

‘The factual inquiry whether to combine references must be thorough and searching.’ It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.

In re Lee, U.S.P.Q.2d 1430, 1433-1434 (Fed. Cir. 2002) (citations omitted, emphasis added).

In connection with the rejection of claim 12, the Office action describes the purported combination of Kuhar and Griswold as follows:

Regarding the spring adjustment system, Griswold discloses a well known adjustment system in the form of knobs and threaded member g and spring K. Such is used to adjust the force exerted by the spring. It would have been obvious to modify Kuhar to have such an adjustment system so as to adjust the blind operation to accommodate different sized blinds. While the knob is not threaded onto the axle g, such is an obvious attachment expedient.

Office Action dated 04/24/02, p. 3.

The Office Action merely states in conclusory terms that Kuhar could be modified with the Griswold system to achieve the invention recited in claim 12. It does not, however,

¹ Relatively recent Federal Circuit cases have clarified that tribunals of the Patent Office are subject to the Administrative Procedure Act. For example, in *In re Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002), the Federal circuit explained:

The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of ‘reasoned decision making.’ Not only must an agency’s decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

* * * *

Judicial review of a Board decision denying an application for patent is thus founded on the obligation of the agency to make the necessary finding and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency’s reasoning in reaching its conclusions.

identify any evidence in the prior art of a motivation for the modification, nor does there appear to be any evidence supporting that motivation in either Kuhar or Griswold.²

Moreover, there does not appear to be any suggestion in Kuhar or Griswold to make the combination set forth in the Office Action.

In order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. See, for example, In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved...

* * *

The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.' (emphasis added, citations omitted).

In order to establish a *prima facie* case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, for example, Ecolochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000) and In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.

² If the Examiner believes that there is such evidence, he is respectfully invited to indicate where it may be found in either Kuhar or Griswold.

* * *

Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific --or even inferential-- findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

* * *

Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. (emphasis added)

The mere fact that references can be modified is not sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" (emphasis original). See *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985) (the prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness). Because the Kuhar and Griswold patents do not appear to provide the necessary motivation or suggestion for the combination proposed by the Examiner, it follows, therefore, that the Kuhar and Griswold patents neither anticipate nor render obvious currently pending claim 12 and claims 13-18 depending therefrom.

Claim 38 is amended to more clearly recite that the blind includes a spring motor adapted to apply a force to a bottom rail in the direction of a headrail, and includes a means for applying a varying amount of weight to the bottom rail to maintain the bottom rail in position with respect to the headrail. Neither Kuhar nor Judkins et al. appear to disclose or suggest a need for varying the weight in the bottom rail to counterbalance the force applied by the spring motor. Kuhar discloses a cordless blind having a spring motor, but does not disclose or suggest applying varying amounts of weight to the bottom rail of the cordless blind to counterbalance the force of the spring motor. Judkins et al. discloses a pleated shade having several alternative embodiments of bottom rails 12 to which an optional weight W

may be added for aesthetic purposes, such as to offset the S-shaped rolling of the pleated shade as the shade is raised and lowered, and to shift the weight of the bottom rail rearward toward a tabbed side of the shade. (See, e.g., Judkins et al., col. 3, lines 24-30, col. 8, lines 12-16 and 35-61, col. 9, lines 60-65, and col. 11, lines 8-15). Judkins et al. does not disclose the use of a spring motor in the shade, let alone applying a varying amount of weight to the bottom rail with the amount applied being adapted to maintain the position of the bottom rail as recited in claim 38. It follows, therefore, that the Kuhar and Judkins et al. patents neither anticipate currently pending claims 38-45, nor render the claims obvious. *See In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985) (the prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness). Because the Kuhar and Judkins et al. patents do not appear to teach or suggest means for applying a varying amount of weight to the bottom rail to counterbalance the force of a spring motor as recited in the claims, the Applicants respectfully request allowance of these claims at the Examiner's earliest convenience.

Regarding claim 49, the claim is amended to more clearly recite that the spring motor is disposed within the headrail or bottom rail, with the balancing adjustment device adapted to be actuated by the consumer from an area external to the headrail or bottom rail. Kuhar does not disclose or suggest a balancing adjustment device in a cordless blind that is actuated external to the headrail or bottom rail and, therefore, Applicants respectfully submit that claim 49 as amended is not anticipated or rendered obvious by Kuhar. Further, for the reasons previously stated with respect to claim 12, the combination of the Kuhar and Griswold patents to arrive at a cordless blind having an adjustment mechanism as suggested by the Examiner in rejecting claims 50-52 is not supported by evidence in the prior art of a motivation or suggestion to make such a combination. Because the Kuhar and Griswold patents do not appear to provide the necessary motivation or suggestion for the combination proposed by the Examiner in the Office Action, it follows, therefore, that the Kuhar and Griswold patents neither anticipate nor render obvious currently pending claim 49 and claims 50 and 51 depending therefrom.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this

application towards allowance, she is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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ATTACHMENT A - VERSION OF THE AMENDED CLAIMS
SHOWING CHANGES MADE IN THIS RESPONSE



1. (Amended) A cordless blind comprising:
 - a headrail;
 - a bottom rail suspended from the headrail by a first cord and a second cord;
 - a window covering disposed between the headrail and the bottom rail;
 - a drive actuator including:
 - a spring motor,
 - a spool coupled to the spring motor and having a first axis,
 - a first tensioning mechanism having a second axis, and
 - a second tensioning mechanism having a third axis,

wherein the first and second tensioning mechanisms are configured to provide a resistant force on movement of the first and second cords, ^{RESPECTIVELY} and wherein the first, second and third axes are parallel.

3. (Amended) The cordless blind of Claim 1, wherein the spring motor includes a storage drum having a fourth axis, an output drum having a fifth axis, and a spring member coupled to the storage drum and the output drum, wherein [the spool, the storage drum, the output drum, and the first and second tensioning mechanisms each have an axis disposed in a generally horizontal direction] the fourth and fifth axes are parallel to the first, second and third axes.

12. (Amended) A cordless blind comprising:
 - a headrail;
 - a bottom rail suspended from the headrail by a first cord and a second cord;
 - a window covering disposed between the headrail and the bottom rail;
 - a drive actuator including:
 - a spool,

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a spring motor coupled to the spool,
a biasing element coupled to the spring motor and configured to provide a force biased against movement of the bottom rail, and
a bias adjustment mechanism coupled to the biasing element, the bias adjustment mechanism being configured to provide a selective variable application of a biasing force by the biasing element.

38. (Amended) A blind comprising:

a headrail;

a bottom rail suspended from the headrail;

a window covering disposed between the headrail and the bottom rail;

[means for selective cordless manipulation of the bottom rail] a spring motor being adapted to apply a force to the bottom rail in the direction of the headrail;

means for [modifying the] applying a varying amount of weight [of] to the bottom rail to counterbalance the force of the spring motor, the amount of weight applied to the bottom rail being adapted to maintain the bottom rail in a given position with respect to the headrail.

39. (Amended) The blind of Claim 38, wherein the means for [modifying the] applying the varying amount of weight [of] to the bottom rail include a tape made from a relatively dense material attached to the bottom rail.

40. (Amended) The blind of Claim 38, wherein the means for [modifying the] applying the varying amount of weight [of] to the bottom rail include an end plug configured to be inserted in an end of the bottom rail.

49. (Amended) A cordless blind comprising:

a headrail;

a bottom rail suspended from the headrail;

a window covering disposed between the headrail and the bottom rail;

a spring motor disposed within one of the headrail and the bottom rail configured to move the bottom rail relative to the top rail;

a balancing adjustment device configured to allow the consumer to adjust the operation of the spring motor, the balancing adjustment device being adapted to be actuated by the consumer from an area external to the one of the headrail and the bottom rail.